

REMARKS

The present Amendment is in response to the Official Action mailed May 12, 2008. Accompanying this communication is a Request for Continued Examination. In the response, claims 1, 8, and 15 have been amended. Therefore, claims 1-15 remain currently pending in the present case. The following sets forth Applicants' remarks pertaining to the currently pending claims and the outstanding Action.

As an initial matter, Applicants respectfully thank both the Examiner and his supervisor for conducting the telephonic interview of July 30, 2008 with Applicants' undersigned counsel. This interview is memorialized by the Interview Summary dated August 6, 2008. In that discussion, Applicants' undersigned counsel pointed out the differences between the present invention and that of the cited prior art. Although no firm agreements were reached as to the currently pending claims, Applicants nonetheless thank the Examiners for indicating that the inclusion of additional structure in such claims may gain a favorable consideration. The present Amendment has been prepared in accordance with these suggestions.

Applicants also thank the Examiner for indicating the allowability of dependent claim 6, but note that they believe broader coverage may be obtained for the present case. As such, Applicants will now discuss the above made amendments of independent claims 1, 8, and 15 in light of the cited prior art.

In the Action, the Examiner first objected to claims 1, 3, and 5 because such claims positively recited elements from the intervertebral disc replacement device which is functionally recited in the preamble of claim 1. The Examiner noted that he is unclear as to whether the claims are directed to a subcombination (*i.e.*, the retaining clip) or the combination (*i.e.*, the retaining clip and the intervertebral disc

replacement device). The Examiner in fact noted that he interpreted the claims as being directed to the subcombination for examination purposes. Applicants agree with the Examiner and refer him to the previous Amendment submitted in the matter (the February 4, 2008 Amendment). In that Amendment, it was made clear that independent claim 1 and its dependent claims were directed to the subcombination of a retaining clip. While certain limitations of the intervertebral disc replacement device are recited in such claims, such is for illustrative purposes only and should not be taken as directing the claim to a combination of the retaining clip and the intervertebral disc replacement device. As such, Applicants respectfully submit that such claims are clear as to their scope and therefore request removal of the objections of claims 1, 3, and 5.

Further in the Action, the Examiner rejected claims 1 and 2 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,888,223 to Bray, Jr. ("Bray"). Essentially, the Examiner noted Bray as teaching each and every one of the limitations of independent claim 1 and dependent claim 2, and in fact included an annotated figure illustrating which of the various elements of a component shown in the Bray reference meet the different limitations of the claims. As was discussed in the aforementioned July 30th telephone discussion, the present invention and Bray differ significantly. One particular difference that was discussed in that telephone discussion is the very different hook flange of the present invention. The Examiners suggested that independent claim 1 be amended to further require that the hook flange of the present invention not only oppose a first side of the body member, but also extend in a parallel direction to that side. Such change has been made to independent claim 1 in the present Amendment, and Applicants respectfully submit that such overcomes the anticipatory rejections of that claim in view of Bray. Simply put, Bray does

not teach a hook flange that opposes and extends parallel to a side of the body member. Likewise, because claim 2 depends from claim 1, the rejections of that claim have also been overcome.

Furthermore, although the Examiner further rejected dependent claims 3-5 and 7 under 35 U.S.C. § 103(a) as being obvious over the combination of Bray and U.S. Patent No. 6,884,242 to LeHuec et al. ("LeHuec"), Applicants respectfully submit that such claims are also allowable based upon their proper dependence from independent claim 1 or an intervening claim. Thus, Applicants present no arguments as to the combination of Bray and LeHuec in rejecting such claims as being obvious.

Still further in the Action, the Examiner rejected claims 8-14 under 35 U.S.C. § 103(a) as being obvious over the combination of U.S. Patent No. 4,217,902 to March ("March") and U.S. Patent Application Publication No. 2005/0033430 to Powers et al. ("Powers"). Essentially, the Examiner noted March as disclosing each and every one of the limitations of such claims save for an enclosure and a second retaining clip attached to the second applicator arm. To support the latter limitation, the Examiner cited Powers. Once again, Applicants note that they have amended independent claim 8 to require that the hook flange have at least one surface opposing and extending parallel to a first side of the body member. This is not taught in either March or Powers. Moreover, Applicants note that independent claim 8 previously included (and still includes) the limitation of at least one lateral flange extending from the body member in a second direction co-planar with the body member. Again, this is clearly not taught by either March or Powers. As such, Applicants respectfully submit that independent claim 8, and its dependent claims 9-14, constitute allowable subject matter.

Finally in the Action, the Examiner rejected claim 15 under 35 U.S.C. § 103(a) as being obvious over the combination of U.S. Patent No. 3,278,107 to Rygg ("Rygg") and Powers. Essentially, the Examiner noted Rygg as teaching each and every one of the limitations of independent claim 15 save for the device further comprising an enclosure. To support the latter limitation the Examiner again cited Powers. In the aforementioned July 30th telephone discussion, the Examiners explained their positions fully with regard to the Rygg reference. Most importantly, they explained that they were not utilizing arms 12 and 13 as meeting the first and second arm limitations of independent claim 15, but rather the split ends at the end of arm 12. Furthermore, they indicated that when one of the clips that are included in the cartridge (see FIG. 5) is engaged with end 14 of arm 12, another clip is also technically removably secured thereto. In response to this, Applicants undersigned counsel suggested amending independent claim 15 to require a "direct contact" between the clips and the first and second arms, respectively, and independent claim 15 has been amended above to require the first retaining clip to be *directly* and removably secured to a first end of the first applicator arm and the second retaining clip to be *directly* and removably secured to a first end of the second applicator arm while the first clip is *directly* and removably secured to the first end of the first applicator arm. Although no formal agreement was reached in the aforementioned telephone interview, both Examiners seem to believe that such an amendment would overcome the cited prior art. As such, Applicants respectfully submit that independent claim 15, as amended, constitutes allowable subject matter.

In light of all of the above, Applicants respectfully submit that claims 1-15 are in a condition of allowance. Although each and every one of the currently pending dependent

claims has not been discussed specifically herein, as such claims constitute allowable subject matter based upon their proper dependence from an allowable independent claim or an allowable intervening claim, Applicants note that such claims may include subject matter in and of itself patentable (e.g., dependent claim 6). Applicants reserve the right to argue such allowable subject matter at a later date, if necessary. Thus, Applicants respectfully request allowance of the present case.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have. If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: November 6, 2008

Respectfully submitted,

By 

Kevin M. Koeun

Registration No.: 54,230

LERNER, DAVID, LITTENBERG,

KRUMHOLZ & MENTLIK, LLP

600 South Avenue West

Westfield, New Jersey 07090

(908) 654-5000

Attorney for Applicants